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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,254	08/22/2003	Tom Brcton	CSI-2026	9420

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JEFFREY J. HOHENSHELL
710 MEDTRONIC PARKWAY
MINNEAPOLIS, MN 55432

EXAMINER

SONNETT, KATHLEEN C

ART UNIT	PAPER NUMBER
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3731

MAIL DATE	DELIVERY MODE
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09/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/646,254

Applicant(s)

BRETON ET AL.

Examiner

Kathleen Sonnett

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 4/19/2007.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 4/19/2007 have been fully considered but they are not persuasive. In response to applicant's argument that the device of Kato is not disclosed with a device that includes multiple piercing members, the device with multiple piercing members is not positively recited in claim 1. The device of Kato must have the positively claimed structure (eversion apparatus comprising an everting member having a looped shaped portion adapted to be inserted into an end portion of a conduit from a human patient) but must only be capable of being used with a device that has multiple piercing members (and capable of folding a portion of the conduit over itself when it is moved away from the conduit end portion and along the conduit while a portion of the conduit is held fixed relative thereto) to anticipate the claim. The language "for preparing a conduit for anastomosis in a human patient using a device with multiple piercing members" is a recitation of the intended use of the claimed invention. If the prior art structure is capable of performing the intended use and has all of the positively recited structure, then it meets the claim.
2. Applicant also argues that the clip ring (60) of Kato is not a support device. However, no structure is given in claim 8 to differentiate the ring (60) of Kato from the claimed support device. It is further noted that the ring provides support for the folded over conduit (see for example, fig. 3c).
3. Applicant also argues that it would not have been obvious to one skilled in the art to modify Kato to include two ends that are slidably mounted in a tubular handle instead of the disclosed one end fixed, one end slidably mounted and also argues that a lack of statement of criticality within a patent application does not establish obviousness. However, Applicant has not disclosed that providing two ends which are slidably mounted as opposed to one end slidably

mounted provides any advantage, serves any particular purpose, or solves a stated problem. Both applicant's invention and Kato's invention would have worked equally well with either two slidable ends or one slidable end since both configurations serve to change the diameter of the loop shaped portion of the eversion device. Since no advantage is given and the device in either configuration would perform the same function of expanding the diameter of the loop shaped portion equally well, this feature would have been considered a mere design consideration. It would have been prima facie obvious to modify Kato to obtain the invention specified in claims 3 or 10 since the modification of two slidable ends as opposed to one slidable end would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Kato.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1,2, 4-9, and 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Kato (US 6,979,337). Kato discloses the invention substantially as claimed including an everting member with a loop-shaped portion (col. 4, lines 24-30) that is coupled to a handle (grip portions [32a] and [32b] or [7] as the handle), wherein the everting member comprises a flexible member having two ends (col. 4, lines 25-35). Regarding claim 4, Kato discloses that one of the ends is movable relative to the handle and the other is fixedly connected to the handle (fig. 5 [81] is the fixed end and [82] is the adjustable end). Regarding claim 5, Kato discloses that both of the ends can be fixedly attached to the handle (fig. 1 [33a] and [33b]). Kato also discloses that the flexible member comprises a pliable wire (col. 4, lines 61-67) and an adjustable diameter (col. 4,

lines 42-45). Regarding claims 8 and those that depend from 8, Kato discloses a vessel support device that the vessel can be flipped over by using the evasion apparatus and wherein the vessel is coupled to and extends from the distal end of the support device (fig. 3A-3C [60]).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato (US 6,979,337). Kato discloses the invention substantially as claimed above but fails to disclose the particular embodiment where both ends of the flexible loop are slidable with respect to the handle. However, due to lack of criticality in the specification, having both ends of the loop being slidably mounted to the handle was shown to solve no particular problem, serve no particular purpose and provide no additional benefit as opposed to having one slidably mounted end and one fixedly attached end. One of ordinary skill, furthermore, would have expected Kato's invention and applicant's invention to perform equally well with either one fixed end and one slidable end as taught by Kato, or the claimed two slidable ends, since both configurations perform the function of changing the diameter of the loop equally well. Therefore, it would have been obvious to have both ends of the loop slidably attached to the handle because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Kato.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathleen Sonnett whose telephone number is 571-272-5576. The examiner can normally be reached on 7:30-5:00, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anh Tuan Nguyen can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



GLENN K. DAWSON
PRIMARY EXAMINER

KCS 9/7/2007